

## **REMARKS**

Claims 1 and 8 are currently pending in the application. Claim 2 has been canceled and incorporated in amended claim 1. Claim 8 has been amended. The specification and drawings have been amended.

The drawings were objected to for allegedly not showing the claimed backing member. Applicants submit that the backing member is shown at numeral 862 of Figure 12 and is described at page 14 lines 4-5 and page 16 lines 4-6. Further, the examiner stated that the drawings do not show the numerals 51, 60, and 55. However, the front wall 51 and the opening 55 are shown in figure 4. The identifier for chamber 60 has been added to Figure 4.

The specification stands objected to for allegedly not disclosing a backing member in conjunction with vertical edges 861 that define a second cutting nip. This position is respectfully traversed. The Examiner is directed to Figure 12 which clearly shows that the vertical cutting edges meet with the backing member 862 to define a nip that cuts the mailpiece 864 as it passes therebetween to create the vertical cuts in mailpiece 87 that result in the castellated appearance of the mailpiece 87 as shown in Figure 12. The Examiner should compare Figure 12 to Figure 11 (no backing member and no vertical cutting edges) to see the difference between the resulting slit appearance in the Figure 11 mailpiece 87 as compared to the castellated appearance of the Figure 12 mailpiece 87. It is submitted that one having ordinary skill in the art can readily identify the first nip formed by the edges 847 and 849 and the second nip formed between the backing member 862 and the vertical cutting edges 861.

The specification stands further rejected for the reasons set forth in paragraph 6 of the Office Action. The specification has been amended to correct the informalities highlighted by the Examiner and to be consistent with the changes to the drawings. Additional amendments were made to correct informalities identified by the Applicants.

Claim 8 stands rejected under 35 U.S.C. first paragraph as not being enabling with respect to the claimed second cutting nip defined between the vertical cutting edges 861 and the backing member 862. As discussed above, the test for enablement is from the viewpoint of one possessing ordinary skill in the art. It is submitted that between the specification sections identified above, claim 8 itself and Figures 11 and 12, one possessing ordinary skill in the art can clearly identify in the specification the relationship of the vertical cutting edges 861 and the backing member 862 to define the second cutting nip.

Claim 8 stands rejected under 35 U.S.C. second paragraph for being indefinite with respect to the second cutting nip. As discussed above, it is submitted that claim 8 particularly points out and distinctly claims the subject matter which applicant regards as the invention since there is no ambiguity as to the second cutting nip.

Claim 1 stands rejected under 35 U.S.C. as being anticipated by Gall. Claim 1 has been amended to include the limitations of claim 2 thereby rendering this rejection moot.

Claim 2 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gall in view of Cavagna. While claim 2 has been cancelled, this rejection is respectfully traversed as it may apply to amended claim 1 which now includes the elements of original claim 2.

Applicants submit that the groove 60 of Cavagna is not the same as the notch of amended claim 1 that is in the first cutting edge. The claimed notch interacts with the

second cutting edge to create a slot in the mailpiece. However, in Cavagna, the groove 60 does not perform any cutting at all. Thus, even if the first cutting blade 3 of Gall were modified to include a groove 60 as set forth in Cavagna, the resulting combination still does not produce the invention of amended claim 1 in that the groove 60 would not contribute to the formation of the claimed slots.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gall in view of Cavagna and Meaden (3,978,752). This rejection is respectfully traversed.

The Examiner's attention is directed to Figure 12 of the specification. The cutting wheels 859 and 805 interact on the mailpiece 87 to create the castellated edge. This edge is created by a first nip defined between the cutting edge 849 of the cutting wheel 805 and the un-notched edge portion of the cutting wheel 859. However, when the vertical cutting edges 861 rotate into position along the mailpiece feed path, they define a second cutting nip with backing member 862. The result is that the first cutting nip produces horizontal slits while the second cutting nip creates the vertical cuts which in combination create the castellated edge.

Meaden is completely different. The cutting edges 18 and 19 of respective cutter wheels 10 and 11 do not even interact to define a cutting nip. Rather, each edge 18, 19 separately cut into a workpiece 24. Cutter wheel 10 has notch portions 20 which permits it to create a line of slits 25. Cutter wheel 11 has groups 21 of notches 22 positioned around its edge 19 to produce the smaller line of slits 27 that are offset from slits 25 by the thickness of the spacer 13 between the cutter wheels 10 and 11. The result of the offset slits 25 and 27 is that a tear line is created in the material 24.

The Examiner refers to vertical edges 22. However, in Meaden, 22 represents the notches in the cutting edge 19 and are not vertical cutting edges extending down from the cutting wheel edge as set forth in the claims. Thus, the configuration of Meaden doesn't have the claimed second cutting nip and cannot produce the castellated edge

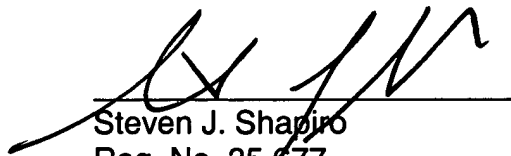
Appln. No.: 10/036,219  
Am'dt. Dated October 31, 2003  
Reply to Office Action dated July 31, 2003

as claimed. Further, there is no combination of the cutting wheels in Gall, Cavagna, and Meaden that can produce the second cutting nip which operates in conjunction with the first cutting nip to produce the castellated edge.

Figures 2, 4, 5, 6, 9, 10, 11, and 12 have been amended. A copy of the Figures with the changes included is being submitted for approval by the examiner. Further, a marked copy showing the changes in red is also being submitted.

It is submitted that the application is in condition for allowance. Reconsideration of the rejections and objections is respectfully requested and an early notice of allowance is earnestly solicited. If the examiner has any questions, please contact the undersigned.

Respectfully submitted,



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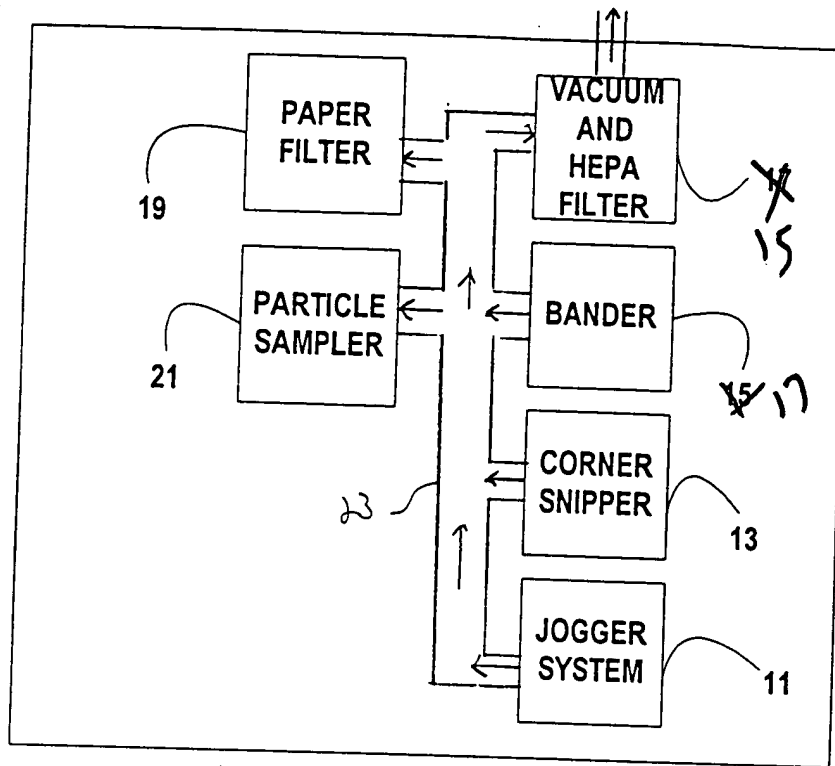


FIG. 2

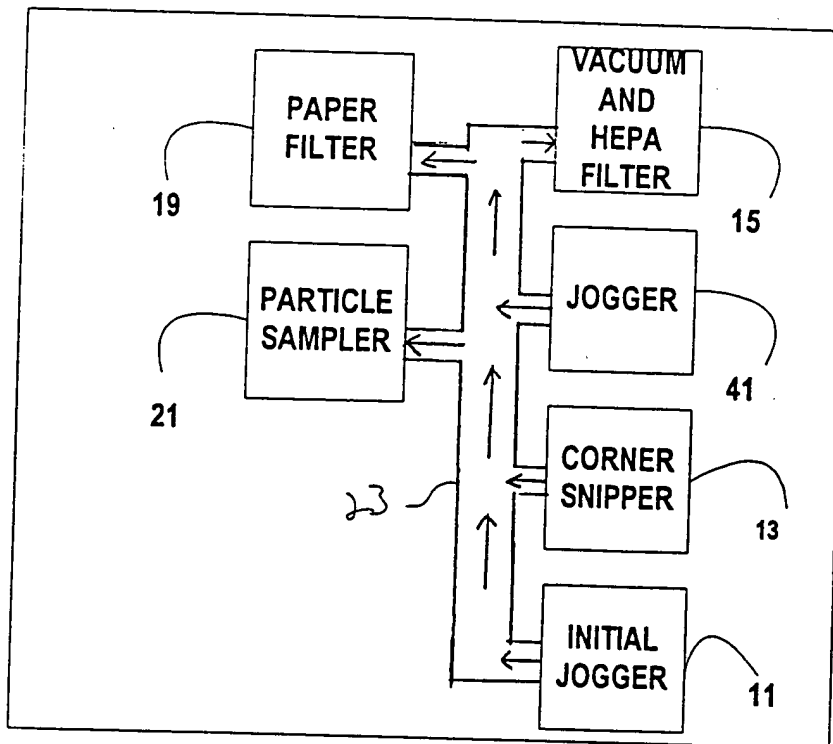


FIG. 7

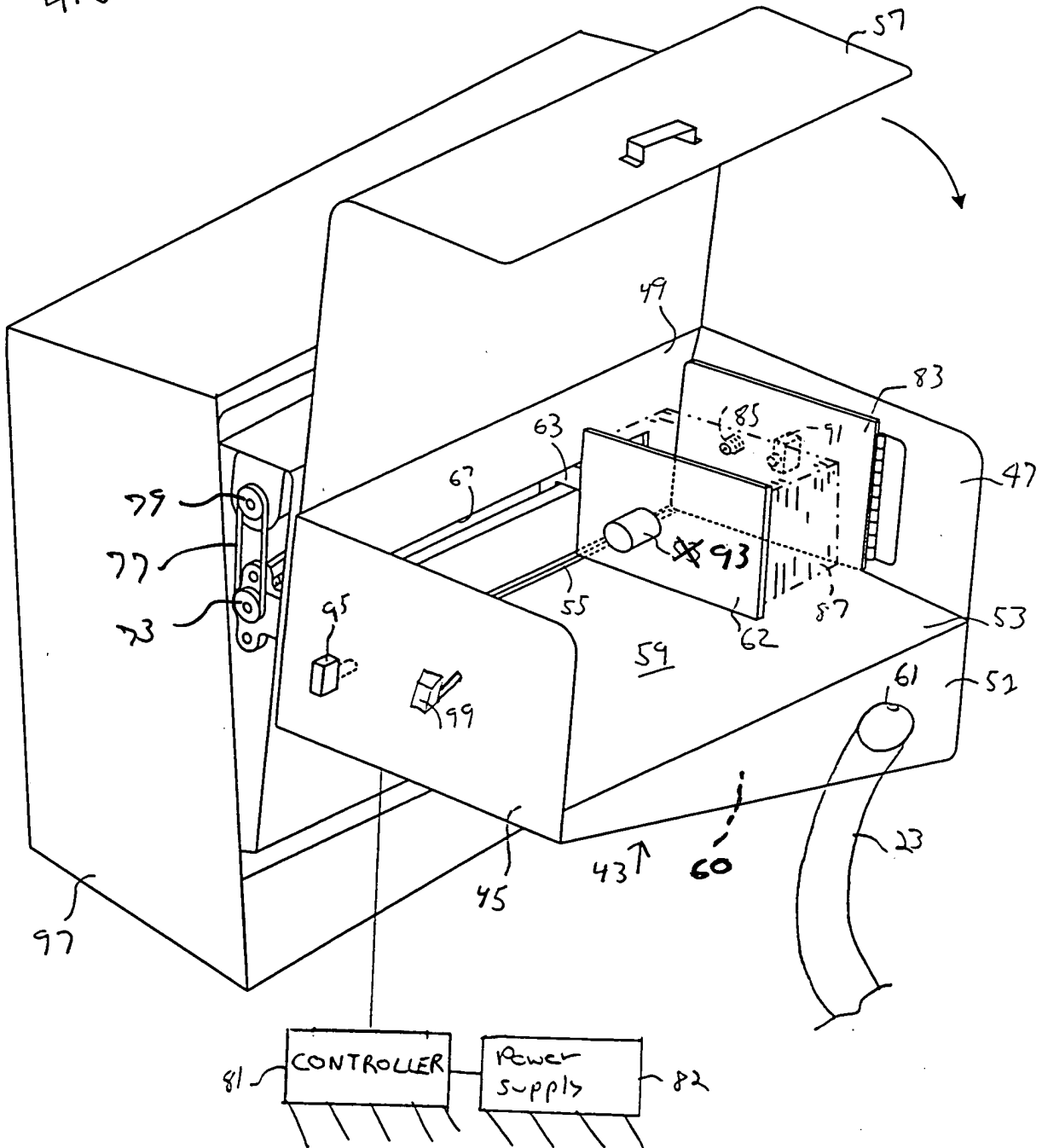
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FIG. 4

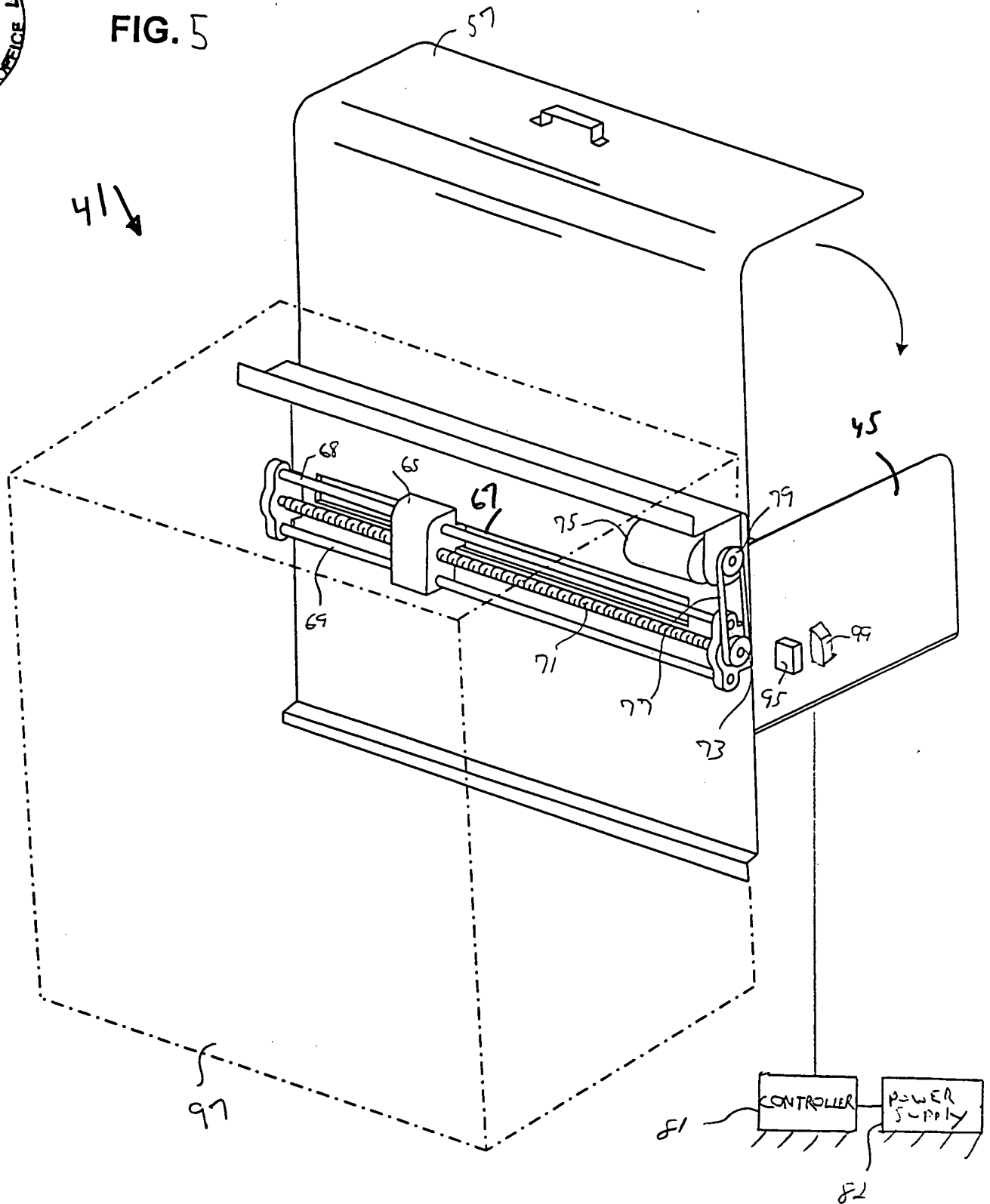
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FIG. 5



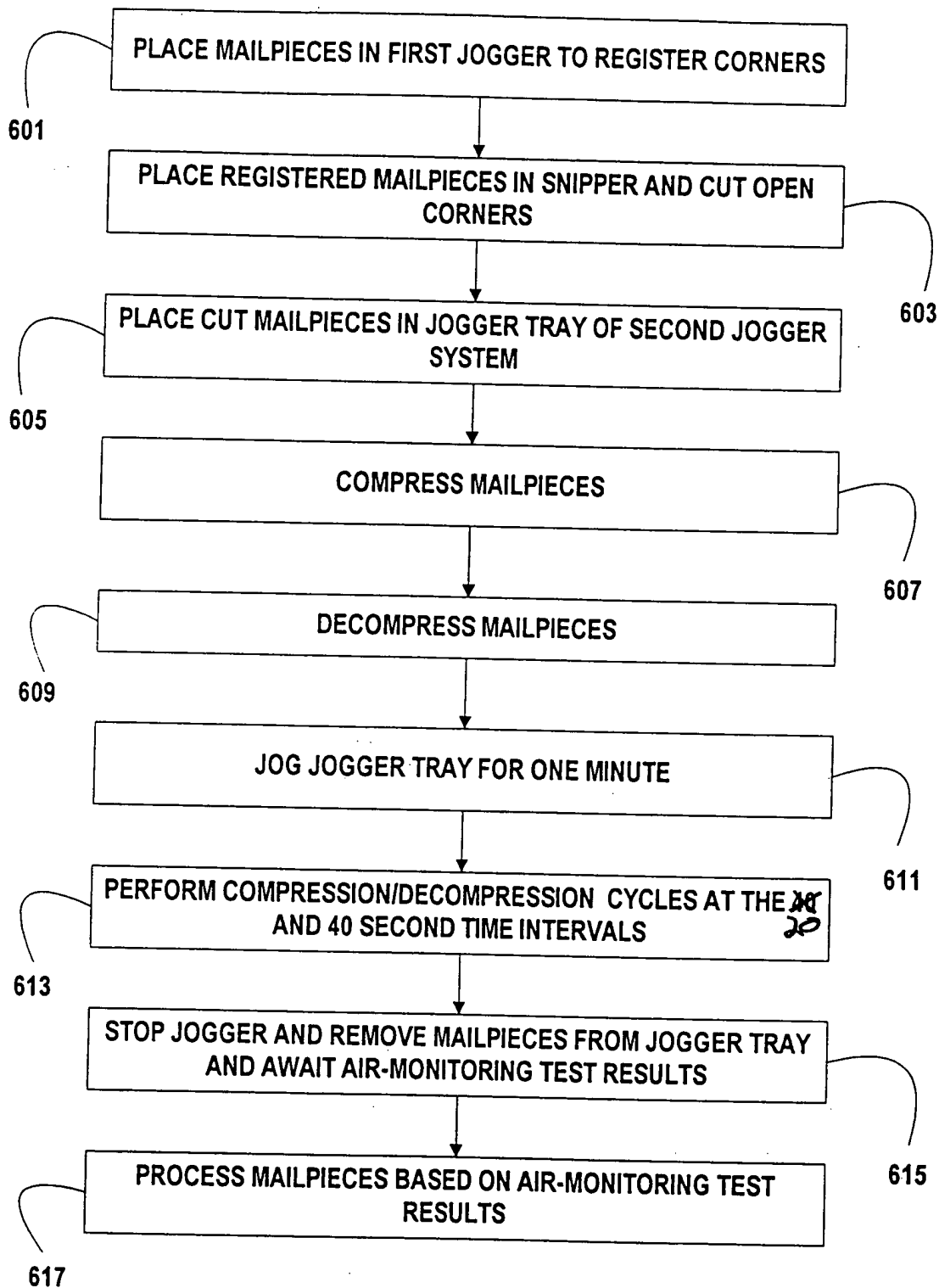




FIG. 9

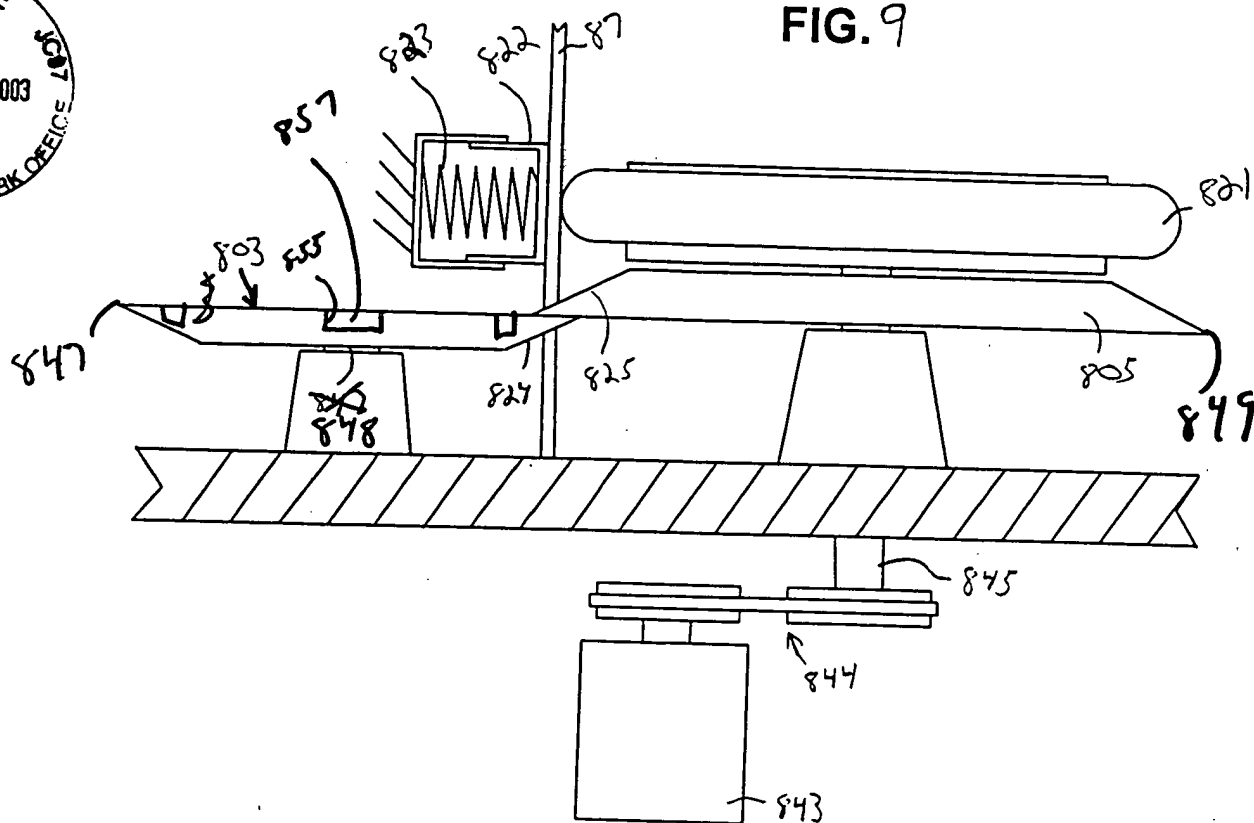
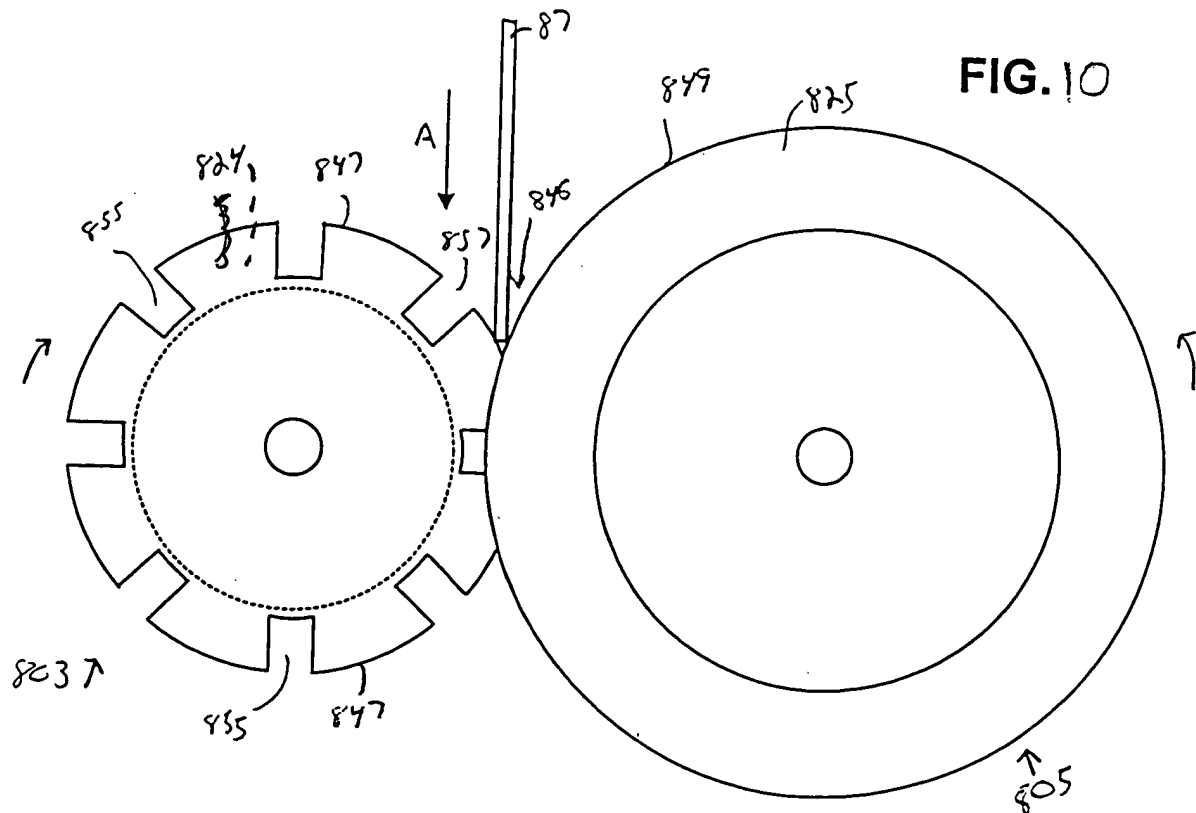
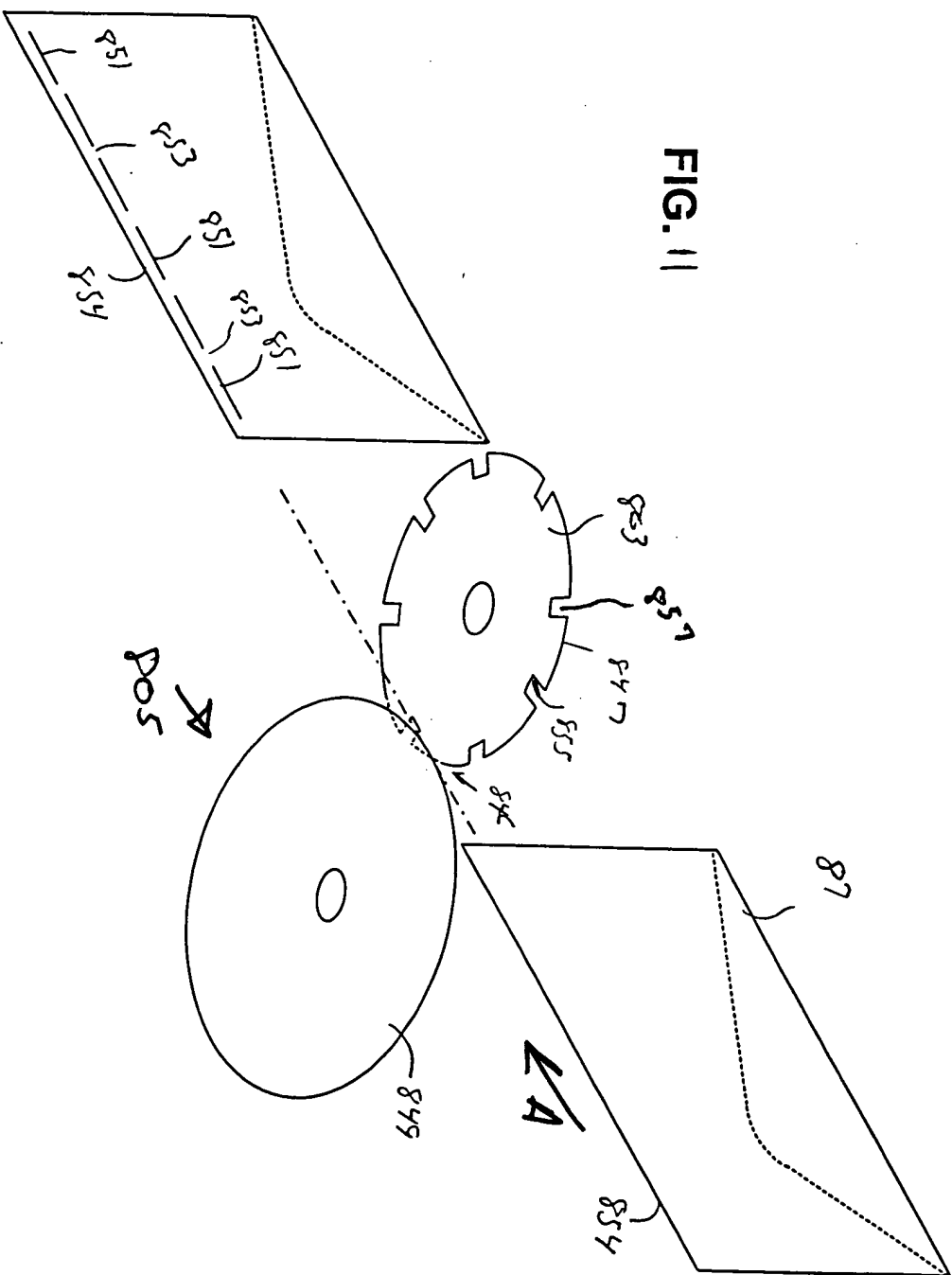


FIG. 10



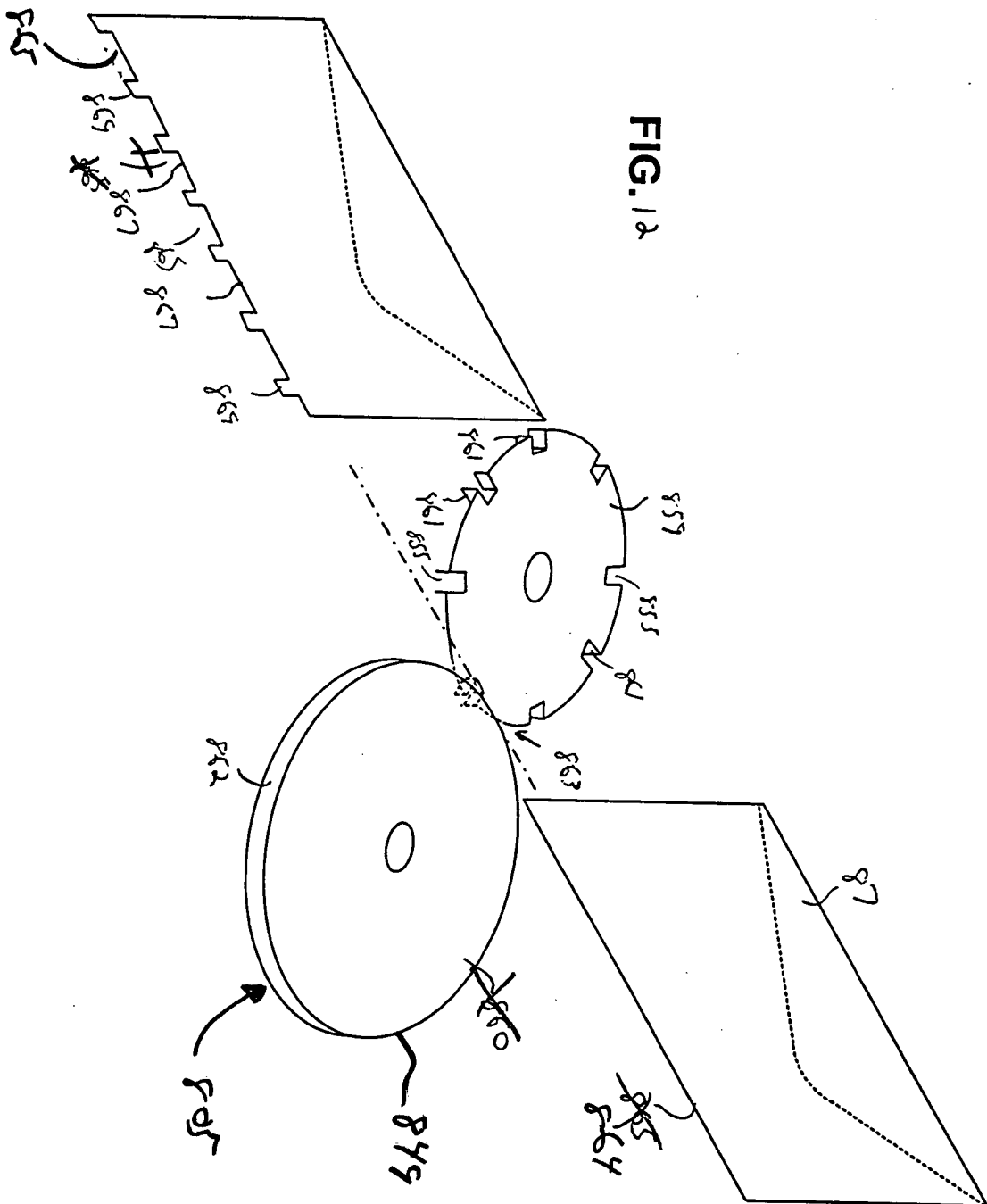


**FIG. 1**



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FIG. 1a



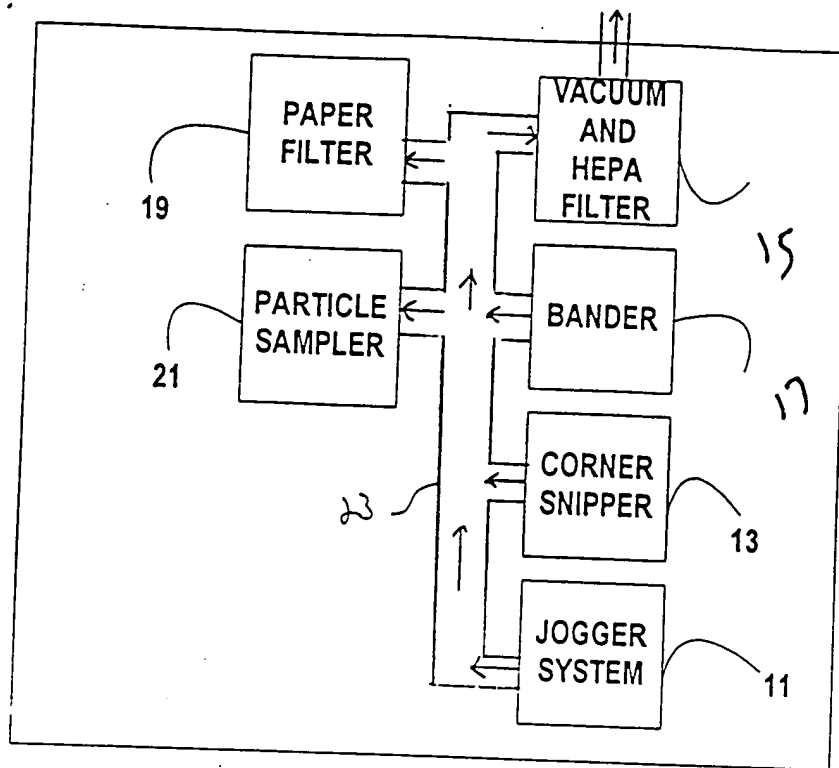


FIG. 2

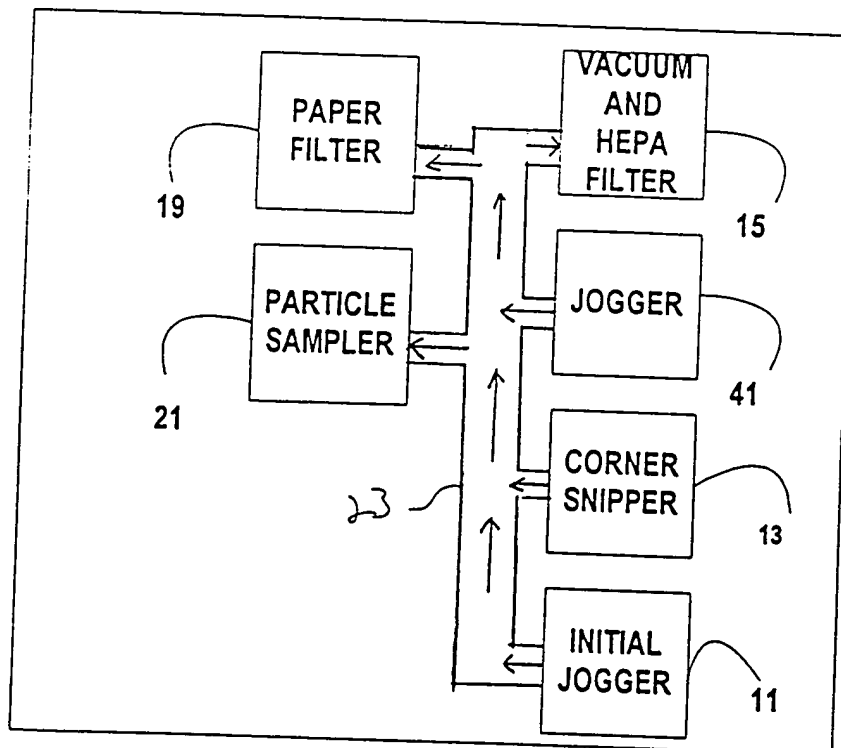
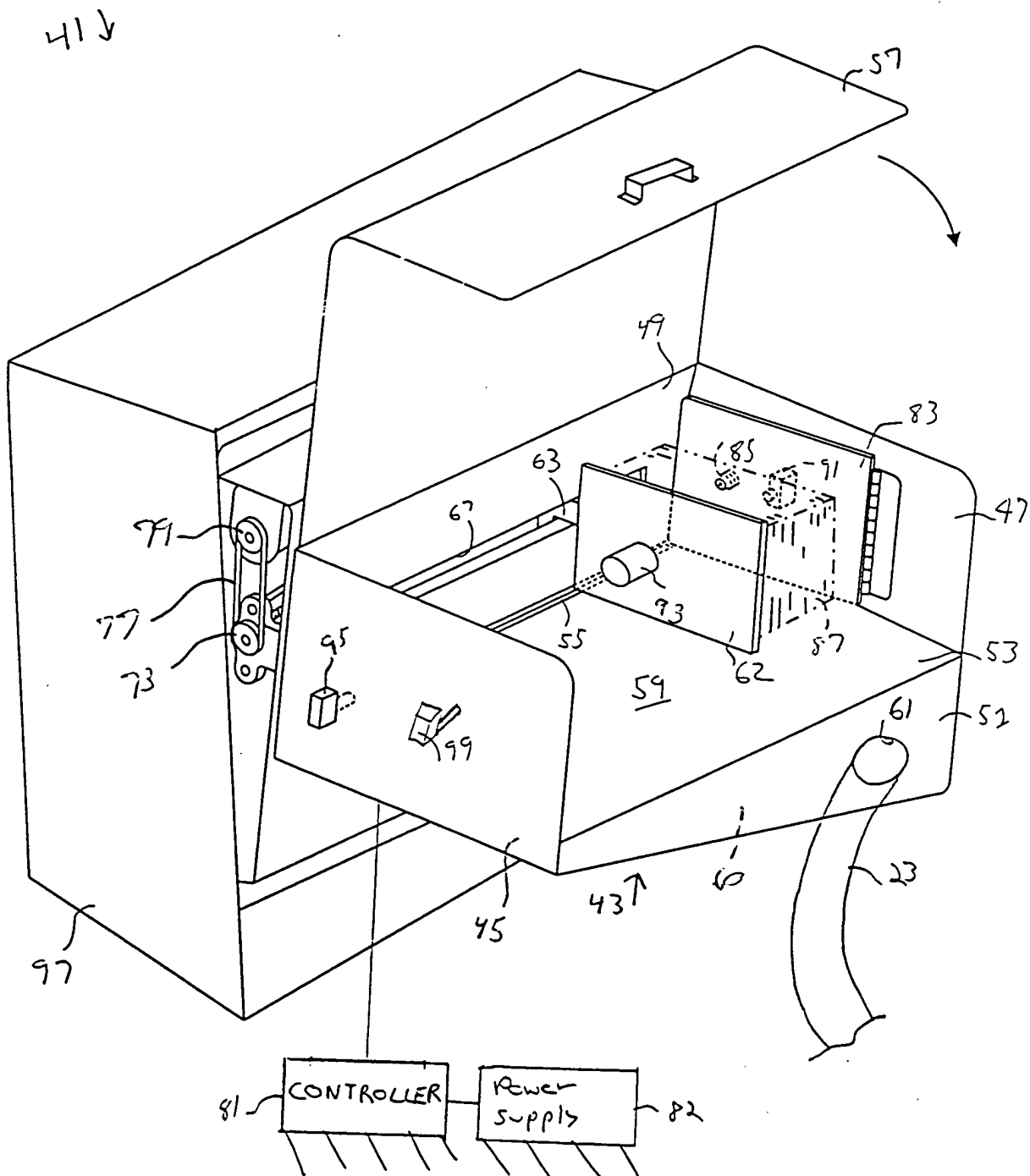


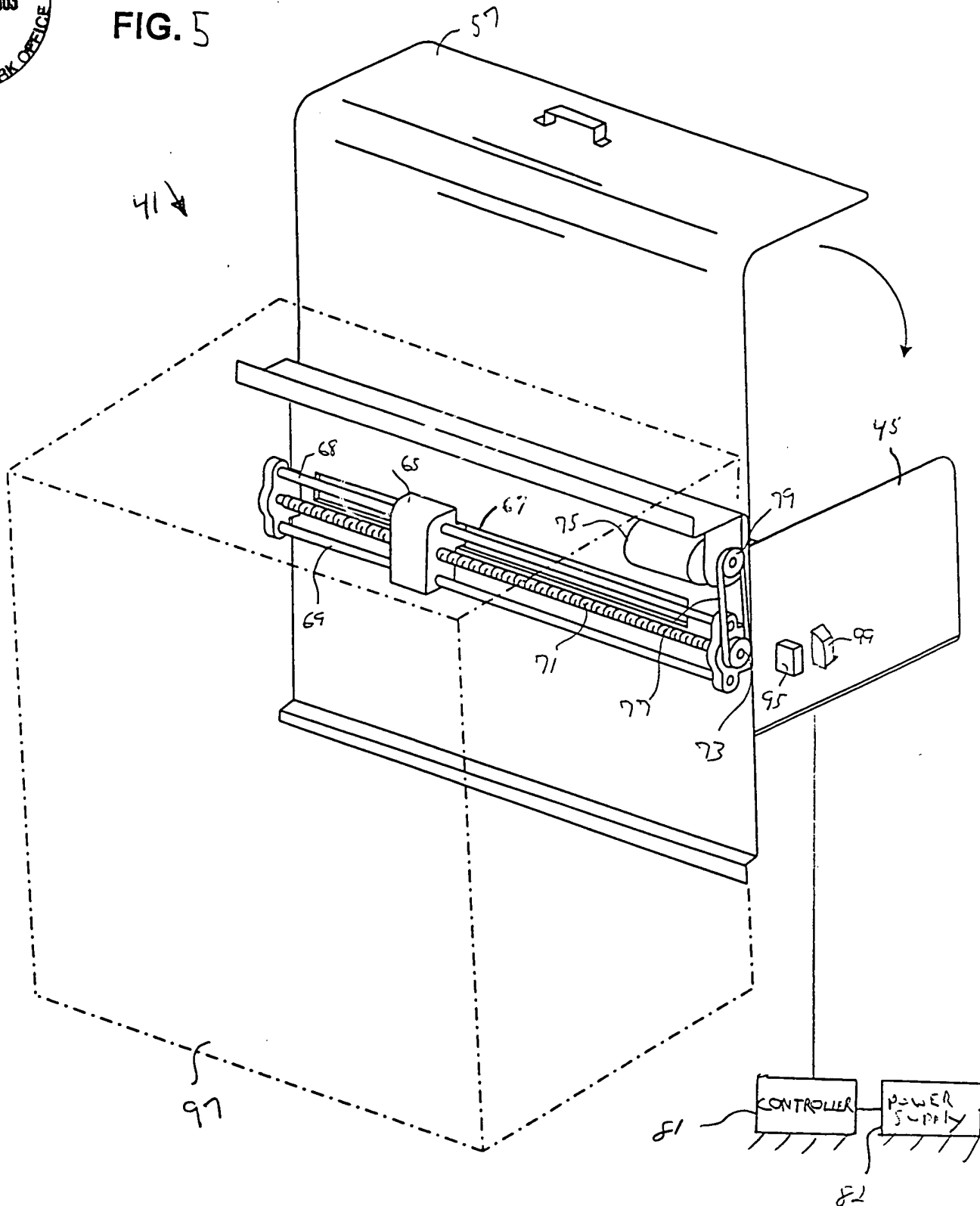
FIG. 7





FIG. 4





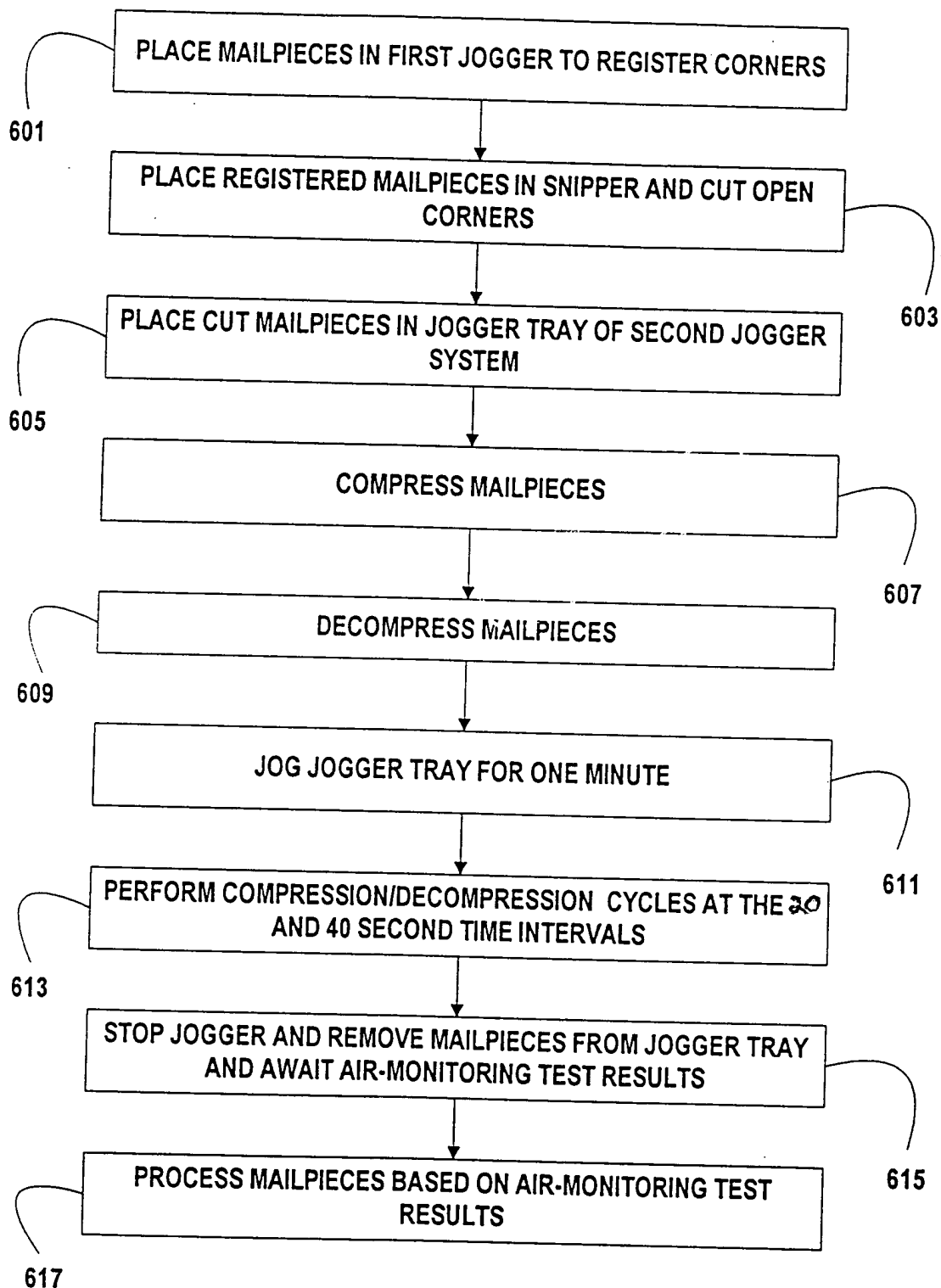




FIG. 9

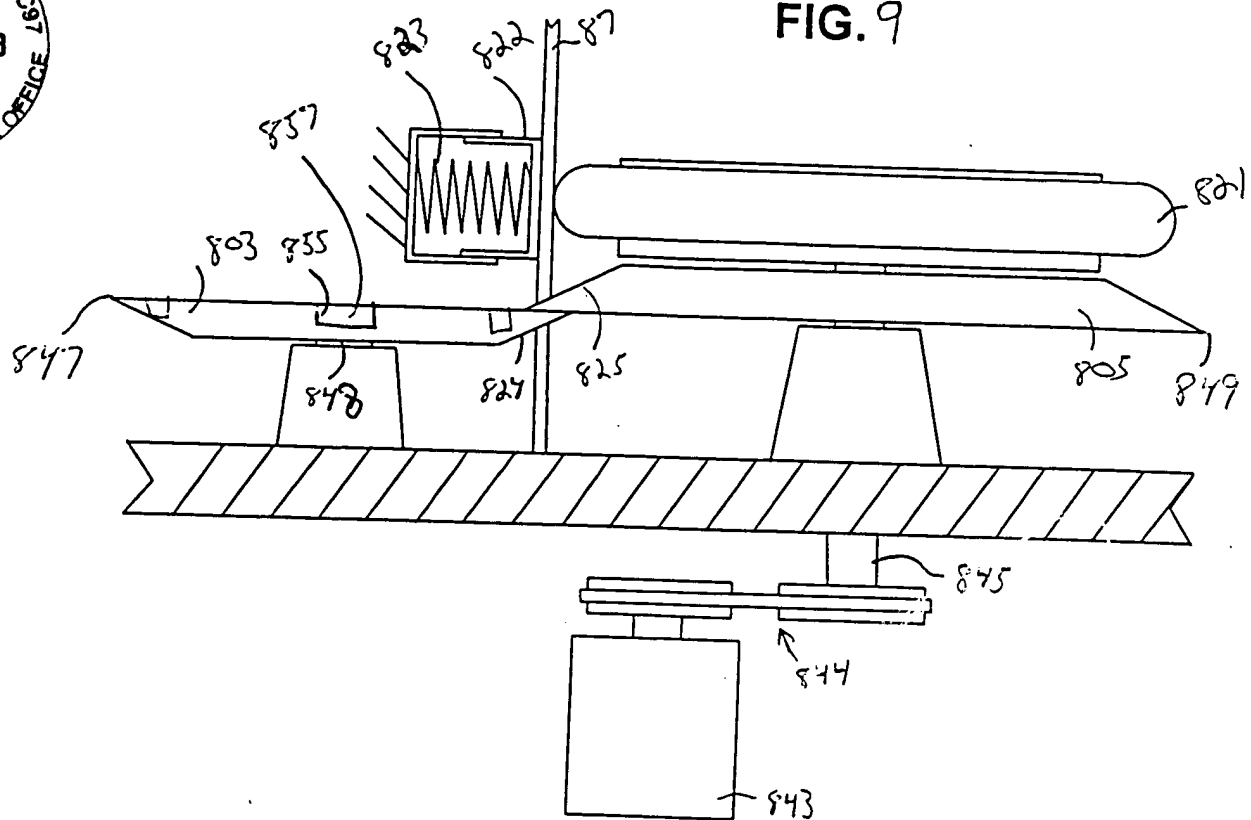
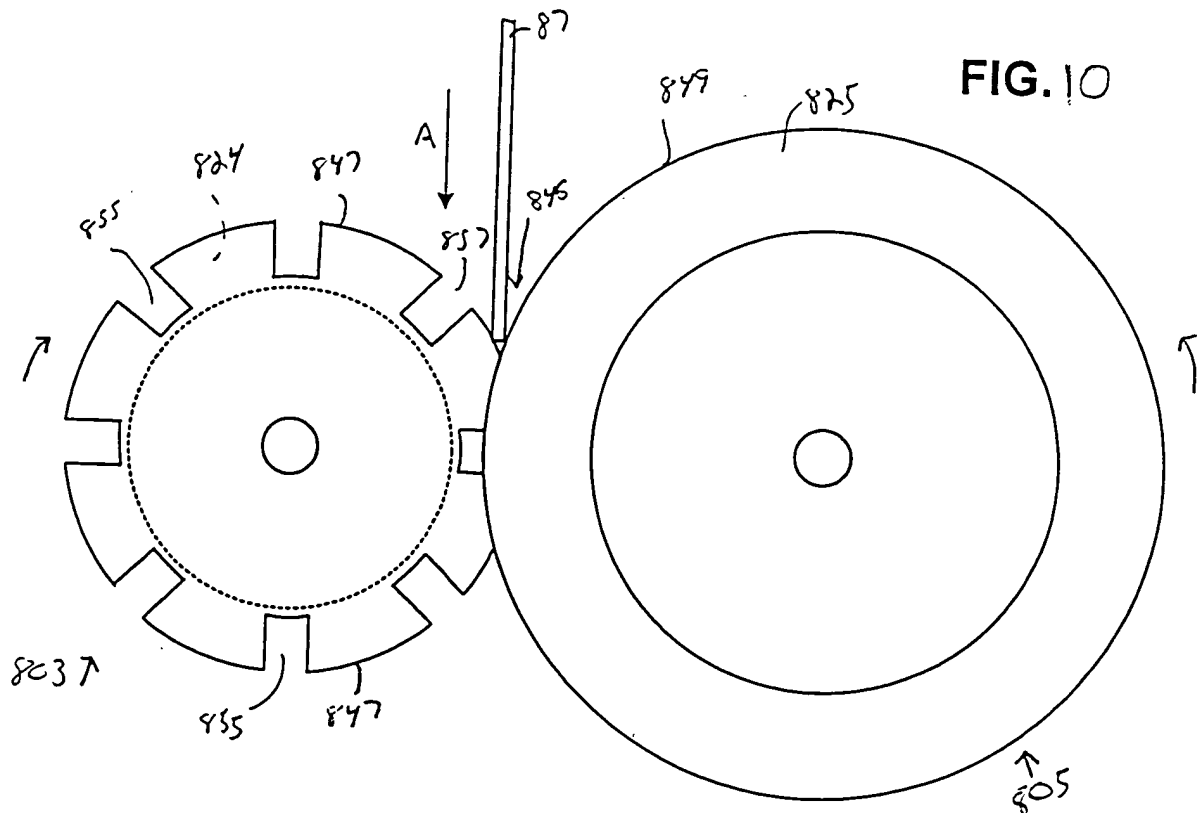
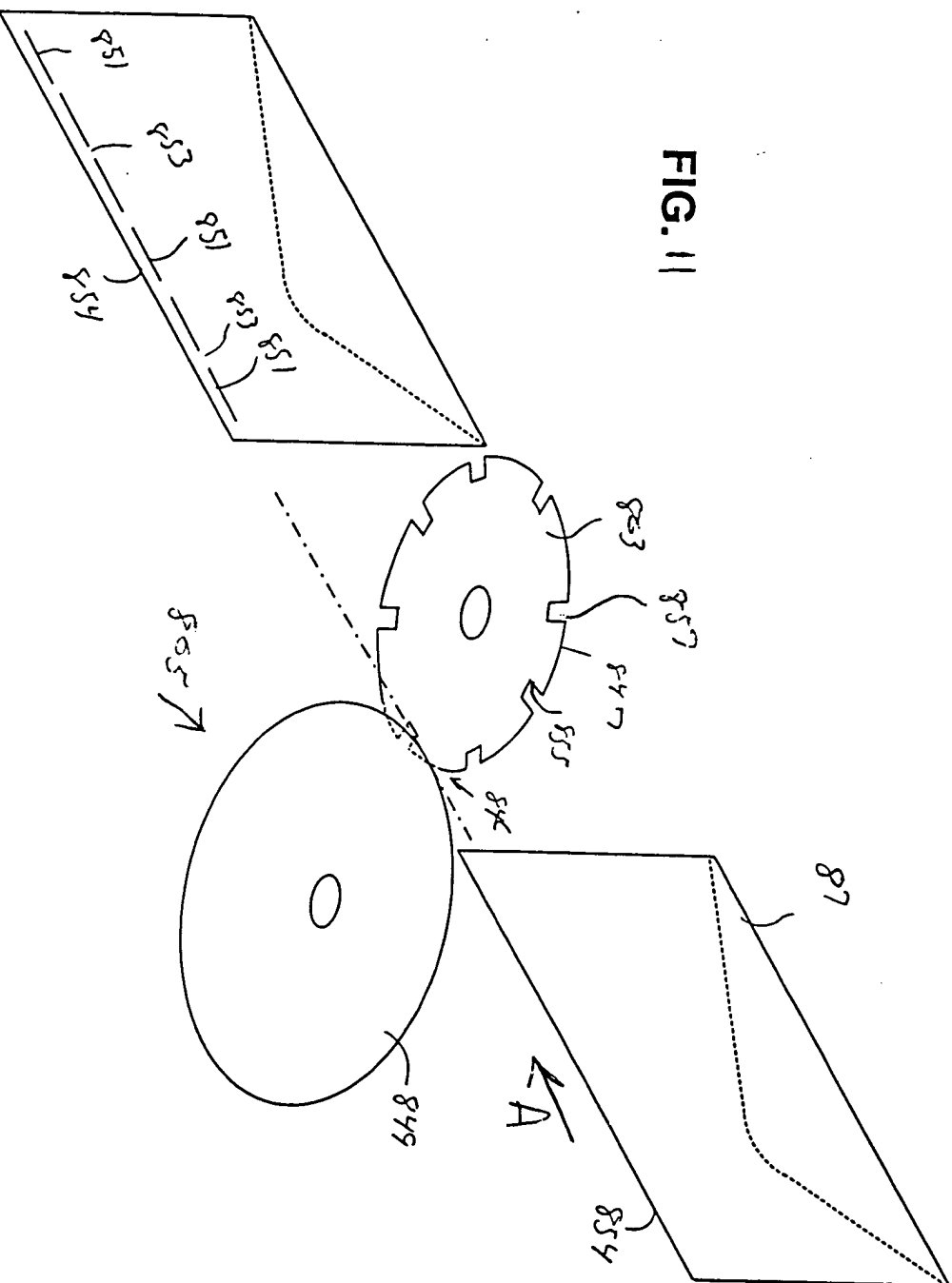


FIG. 10







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FIG. 1a

